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In re Application of
BURROUGHES et al
Application No.: 09/913,381
PCT No.: PCT/GB00/00476
Int. Filing Date: 14 February 2000
Priority Date: 12 February 1999
Attorney's Docket No.: 29610/CDT087A
For: OPTO-ELECTRICAL DEVICES

DECISION

ON PETITION

UNDER 37 CFR 1.47(a)

This decision is in response to applicant's "PETITION UNDER 37 CFR §1.47(a) INVENTORS REFUSE TO SIGN" filed on 29 January 2002 to accept the above-captioned application without the signature of the non-signing joint inventor- Ian S. Millard. Petitioner has submitted the requisite \$130 petition fee.

BACKGROUND

On 14 February 2000, applicant filed international application PCT/GB00/00476, which claimed an earliest priority date of 12 February 1999. A copy of the international application was transmitted to the United States from the International Bureau on 17 August 2000. A Demand electing the US was filed within 19 months from the priority date.

On 13 August 2001, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, inter alia, the requisite basic national fee as required by 35 U.S.C. 371(c)(1). No oath or declaration was submitted at such time.

On 22 October 2001, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance 37 CFR 1.497(a) and (b) is required. The notification set two months time limit or 32 months from the priority date for the application, whichever is later to respond.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Applicants have satisfied requirements (1), (3), and (4) of 37 CFR 1.47(a). However, requirement (2) has not been satisfied.

Section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.) **Proof of Unavailability or Refusal**, the relevant sections states, in part:

“...Where a refusal of the inventor to sign the application paper is alleged, the circumstances of the refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings and oath or declaration) to the nonsigning inventor for signature.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.”

In this case, it has not been sufficiently demonstrated that a copy of the application papers were presented to the nonsigning inventor. Petitioner asserts that the documents were mailed to Mr. Millard's last known residential address. However, no documentary evidence to support this assertion has been provided (e.g. certified mail return receipt). Moreover, it appears unlikely that Mr. Millard resides at the UK address given petitioner assertion that Mr. Millard works in California. With regard to mailing of the application papers to Osram Opto Semiconductors, Inc, petitioner has not established that Mr. Millard was employed at Osram's San Jose site during the relevant period.

Mr. Millard's failure to respond given that it is unclear if he actually received the documents can not be construed as a refusal at this time. It could be that in this situation that Mr. Millard has moved both from his last known address and from his job, and the reason for no replies. If such is case, then the petition should address that there was an inability to find or reach the nonsigning inventor, Mr. Millard, after diligent effort.

Consequently, the petition does not include sufficient factual proof that Mr. Millard refused to sign the required documents.

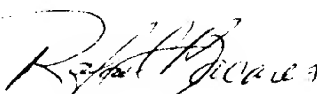
CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration of the merits of the petition under 37 CFR 1.47(a) is desired, applicant must file a request for reconsideration within **TWO (2) MONTHS** from the mail date of this Decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." Extensions of time are available under 37 CFR 1.136(a).

A proper reply to this decision must include : 1) sufficient proof of refusal or unavailability required under 37 CFR 1.47(a) as indicated above (or an oath/declaration in compliance with 1.497(a)-(b)), and 2) failure to timely submitted the proper reply will result in abandonment of the application.

Any further correspondence with respect to this matter should be addressed to the Commissioner for Patents, Office of PCT Legal Administration, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office



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